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10/755,135	01/12/2004	Earl Votolato	12,577	2605

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EXAMINER
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SOLD, JENA A

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/755,135

Applicant(s)

VOTOLATO, EARL

Examiner

Jena A. Sold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/12/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to for the following reason:

1. In Figure 6, first finger is shown as 26 and third finger is shown as 27. However, in Figure 7, first finger, the index finger, is labeled as 27 and third finger, the ring finger is labeled as 26, so that the reference characters appear to be reversed, mislabeling the first and third fingers.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 12 is objected to because it refers to "The method of claim 1." Claim 1, however, is not a method claim. For the purpose of further evaluation, it is assumed that claim 12 was intended to disclose "The method of claim 10." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 recites the limitation "The method of guarding the first, third and middle fingers of a culinary worker...." There is insufficient antecedent basis for the statement "The method" in the claim because said statement refers back to a method that has not yet been disclosed or claimed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Deglon (FR 2 801 090). As visible in Figures 1 and 3, Deglon discloses a finger-

protection device 1, for use in the preparation of foods comprising a shield 2, present applicant's "culinary finger guard plate," a retaining ring 3 which is attached to said shield so that two separate projections, present applicant's "finger guards," extend from a side of the plate and have a space between them to receive a user's middle finger and allow the user's middle finger to extend generally parallel to the plate (page 3, lines 1-3). Each said projecting finger guard, additionally, has a finger retention portion, ends 11 and 12, which overhang the shield 2. As the projecting finger guards of the ring, and thus the finger retention portions of said finger guards, are sufficiently elastic to allow variation in the space between finger retention portions 11, 12, the spaces provided between the overhand portions and the plate for the user's first and third fingers (see Figure 3, the areas between 11 and 9, and 12 and 10) are likewise adjustable (page 3, lines 12-17).

5. With regard to claim 2, said finger retention portions 11, 12 are visibly arcuate and have concave sides facing the plate, each guard having a terminal spaced from the plate at ends 11 and 12, said terminals considered to be the end points of the finger retention portions. Additionally, each guard has cantilever support by the plate as it projects outwardly in a generally perpendicular manner from the vertical support, or shield.

6. With regard to claims 3 and 4, and as visible in Figure 3, said shield has a concave face, the interior face (page 3, lines 10-11), which faces toward the finger guards.

7. With regard to claim 5, said finger guards are considered to be “generally parallel” projections defining, therebetween, a space for the middle finger, as the limitation “generally parallel” is vague and indefinite, and the curvature of Deglon’s finger guards mimics the curvature of present applicant’s finger guards, as depicted in Figure 1. Additionally, as Deglon’s finger guards are sufficiently elastic to allow changes in the diameter of the space for the middle finger (page 3, lines 14-17), said finger guards are considered sufficiently elastic to be bent into more or less parallel configurations.

8. With regard to claim 8, said finger guards are configured to flex relatively toward one another to sidewardly grip user’s middle finger, depending on the size of the user’s hand and the diameter of the user’s finger (page 3, lines 14-17; page 5, claims 3 and 4).

9. With regard to claim 9, each of said finger guards has a hook shape wherein ends 11, 12 form said hook shape in their arcuate configuration (Figure 3).

10. With regard to claims 10, Deglon discloses the device as defined in claim 1 wherein the finger protective device is specifically intended to be held on the hand by placing the middle finger through the ring 3, between the two finger guards, as visible in Figure 5, and as disclosed in the present application. Additionally, the shield covers three fingers of the hand in particular – the index, or first, finger, the middle finger and the ring, or third, finger - so that when the middle finger is placed between the two finger guards, the first and third fingers, protected by the shield, necessarily fall beneath the finger retention portions (page 3, lines 18-23). Lastly, as described on page 3, lines 31-34, the device protects the fingers, which are shielded from the knife during the cutting

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of objects, particularly fruits and vegetables. Thus, present applicant's method of claim 10 is inherent in Deglon's finger-protection device.

11. With regard to claim 11, the user's middle finger, when larger in diameter than ring 3, is necessarily wiggled in a back and forth motion in order to properly size the ring and insert said finger into said ring. Thus, in the movement of said middle finger, the first and third fingers of the user necessarily move back and forth as well, exerting sideward forces against the guard portions at opposite sides of the spacing therebetween, during insertion of the middle finger into said spacing.

12. With regard to claim 12, and as discussed in paragraphs 5 and 8 above, each guard is provided a terminal spaced from the plate and is constructed of sufficiently elastic material to allow the guard to flex during culinary use.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 6, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Romanov (U.S. 6729510). Romanov discloses a hand protection device 50 comprising shield 110 and holder 170 (column 3, lines 53-54), holder 170 alternatively formed by two arcuate, opposed, semi-cylindrical spring arms, present applicant's "finger guards,"

extend from a side of the plate and have a space between them to receive a user's middle finger and allow the user's middle finger to extend generally parallel to the plate (column 4, lines 33-38). Additionally, said finger guards have finger retention portions, as visible in Figure 4, which overhang the plate and provide spaces, on either side of finger guards of holder 170 capable of receiving user's first and third fingers, in between said overhang portion and said shield. As "finger holder 170 has sufficient flexibility and resilience that it will accommodate... a wide range of finger thickness[es]" (column 4, lines 37-42), said spaces for the first and third fingers are likewise adjustable as adjustment of finger holder 170 necessarily alters the space on either of its sides.

14. With regard to claim 6, Romanov discloses said hand protection device 50 wherein it may be made from a lightweight, thermoplastic material material, such as polyethylene, polypropylene, or polystyrene (column 4, lines 50-53). As the two finger guards of holder 170 are intended to be flexible to adjust for and accommodate a range of finger sizes, the guards are inherently sufficiently thin to flex toward one another in response to first and third finger sideways pressure exertion, which is interpreted to mean the use of the first and third fingers to exert pressure in a sideways direction.

15. With regard to claim 7, it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding (In re Hotte, 177 USPQ 326, 328 (CCPA 1973)). Thus, finger holder 170 including finger guards, attached to the rear face of the middle section 160 of the shield, or formed by two spring arms attached to the rear face of the middle section 160 (column 4, lines 30-36), is considered integral with shield 110.

**Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jena A. Sold whose telephone number is (571) 272-4610. The examiner can normally be reached on Mon. - Fri. 8:30 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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GARY L. WELCH  
PRIMARY EXAMINER